

### **REMARKS/ARGUMENTS**

Applicants would like to thank the Examiner for the careful consideration given the present application, and for the personal interview conducted on March 23, 2006. The application has been carefully reviewed in light of the Office Action and interview, and it is respectfully submitted that the application, as amended, is patentable over the art of record. Reconsideration of the application as amended is respectfully requested.

Claims 1-11 remain in this application. Claim 9 has been canceled. Claims 12-15 have been added. Claim 4, which has been amended, has been previously allowed.

The Examiner objected to claim 5 for reciting features already found in claim 10. Claim 5 has been amended to depend only on claim 4, and thus the objection is moot.

Claim 6 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite based on claim language of claim 10. Because claim 5 has been amended to no longer depend on claim 10, this rejection is moot.

Claims 1-2, 5, 7-8, 10 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue *et al.* (U.S. Patent No. 6,618,586) in view of Rasmussen (U.S. 5,134,717) and further in view of Sone (U.S. 6,223,057). Claim 3 was rejected as above in further view of Kurosawa *et al.* (U.K. 2,331,890). For the following reasons, the Examiner's rejections are respectfully traversed.

Claim 1, as amended, recites "a plurality of user selectable directories user selectable for storing user selected phone numbers by a *display means displaying a plurality of names corresponding to each of the plurality of user selectable directories*, the user selectable telephone directories being associated with said external memory device, said directories for storing said selected telephone numbers" wherein "a user can register a telephone number stored in the

temporary storage memory in one of said user selectable directories selected from the plurality of user selectable telephone directories by *selecting one o the names displayed by said display means* after making a call". None of the cited references cite any display means for displaying the names of a plurality of directories. Thus, claim 1 is patentable over the references.

Claim 10 recites at least three memories: a temporary storage memory, an internal memory (claim 1) or a "telephone directory memory different from said temporary storage memory" (claim 10), and an external memory device.

The Examiner has cited no reference that teaches three such memories. Instead, the Examiner cites Inoue as teaching the first two memories, but must cite Sogaard as teaching an external memory. However, the Examiner has not provided the proper motivation for adding an external memory to Inoue. Instead, the Examiner merely states that the motivation would to enable "the extension of memory space and flexibility of stored telephone numbers." This broad and generic benefit is not a legally sufficient motivation. The Examiner is reminded that to support a prima facie case of obviousness, the Examiner must provide a logical rationale for combining the references that can be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the specific combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time

to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not piecemeal.

Thus, the Examiner has not supported a prima facie case of obviousness, and thus the rejection cannot stand.

New claim 13 recites that "one of the plurality of telephone directories is chosen in advance by a user for automatically storing the telephone number stored in the temporary storage memory after making or receiving a call." This feature is not found in any of the cited references, and thus claim 13 is patentable over the art of record.

New claim 15 recites limitations that are similar to those relied upon by the Examiner for the allowability of claim 4, and thus new claim 15 is patentable over the references for similar reasons.

Finally, the remaining claims depend on at least one of the above discussed claims, and thus are patentable over the references for at least the same reasons as the parent claim(s).

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

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If there are any additional fees resulting from this communication, please charge the same  
to our Deposit Account No. 16-0820, our Order No. 32739.

Respectfully submitted,

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